

REMARKS

In response to the restriction requirement set forth in the Office Action, Applicants hereby elect with traverse Claims 1-5, 20-26, 31-37, and 58-62, in Group I, for examination.

Further, the Applicants respectfully request reconsideration of the Restriction Requirement in light of the remarks presented herein. Claims 6-8, 11-16, 27-29, 38-40, 42, 43, 46-50, 54-57, and 63-68 have been withdrawn pending any such reconsideration.

I. STATUS OF CLAIMS

Claims 6-8, 11-16, 27-29, 38-40, 42, 43, 46-50, 54-57, and 63-68 have been withdrawn. Claims 1-5, 20-26, 31-37, and 58-62, in Group I, have been selected for examination and are pending in the application.

II. RESPONSE TO THE RESTRICTION REQUIREMENT

- A. Because there is no serious burden on the Examiner in examining the claims in the present application, the Restriction Requirement is not proper and must be withdrawn.

In MPEP § 803, subsection titled “CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS”, it is stated that:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:
(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
(B) **There would be a serious burden on the examiner if restriction is not required** (see MPEP § 803.02, § 808, and § 808.02). (Emphasis added.)

MPEP § 803, in the subsection titled “GUIDELINES”, continues to state that:

For the purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

The Applicants respectfully submit that the Restriction Requirement set forth in the Office Action must be withdrawn because the Office Action has failed to establish a *prima facie* showing that a serious burden exists on the examiner in examining the claims in the present application as required by MPEP § 803.

Specifically, the Applicants respectfully submit that in light of the prosecution history of the present application up to the present Office Action, it is not credible for the Office Action to assert that there is a serious burden in examining all the claims in the same application. In support, the Applicants provide below a brief recap of the prosecution history:

1. The present application was filed on April 13, 2001.
2. On September 22, 2004, Examiner Ramsey Refai telephoned Applicant's Representative Mr. Craig Holmes to discuss a First Restriction Requirement.
3. On September 23, 2004, Applicant's Representative Mr. Craig Holmes held a telephone conversation with Examiner Ramsey Refai and orally accepted, without traverse, Group I, which consisted of Claims 1-16, 20-29, and 31-40.
4. Based on the examination of each of Claims 1-16, 20-29, and 31-40, a First Office Action was mailed on October 22, 2004.
5. On January 25, 2005, Applicant's Representative filed a response to the First Office Action. In the response, dependent Claims 42-57 were added, which claims correspond to already-examined dependent claims (i.e., Claims 7-15) of a different statutory class.

6. Based on the examination of each of Claims 1-16, 20-29, 31-40, and 42-57, a Second and Final Office Action was mailed to Applicant's Representative on May 23, 2005.
7. On July 20, 2005, Applicant's Representative mailed a Request for Continued Examination (RCE) and a response to the Second and Final Office Action. In the response, the independent claims were clarified with a minor amendment and dependent Claims 58-59 were added, which claims correspond to already-examined dependent claims (i.e., Claims 25-26) of a different statutory class.
8. Based on the examination of each of Claims 1-16, 20-29, 31-40, and 42-59, a Third and Non-Final Office Action was mailed on August 19, 2005.
9. Applicants' Representative Mr. Craig Holmes conducted a Telephone Interview with Examiner Ramsey Refai on December 15, 2005. An agreement was not reached during the interview.
10. An Interview Summary was mailed to the Applicant's Representative on December 21, 2005.
11. On December 19, 2005, Applicant's Representative mailed a response to the Third Office Action. In the response, dependent Claims 60-68 were added, dependent Claims 9, 10, 44-45, and 52-53 were canceled, and dependent Claims 8, 43, and 51 were amended to incorporate, respectively, the subject matter of the canceled claims.
12. On March 27, 2006, a Notice of Non-Compliant Amendment was mailed to Applicant's Representative.
13. On April 6, 2006, Applicant's Representative mailed a reply to the Notice.

14. Based on the examination of all the pending claims, a Fourth and Final Rejection was mailed to Applicant's Representative on July 18, 2006.
15. On October 18, 2006, Applicant's Representative mailed a Notice of Appeal.
16. On February 14, 2007, Applicant's Representative mailed an Appeal Brief.
17. Based on the examination of all the pending claims, a Fifth and Non-Final Office Action was mailed on October 17, 2007. The Fifth Office Action maintained the rejections and further rejected the computer-readable medium claims under 35 U.S.C § 101 as allegedly directed to non-statutory subject matter.
18. On January 15, 2008, Applicant's Representative filed a response to the Fifth Office Action. In the response, the Applicants amended only the rejected computer-readable medium claims to recite a computer-readable storage medium.

Thus, before mailing the present Sixth Office Action, the Examiner has already issued a Restriction Requirement, has issued a total of five Office Actions (two of which were Final Office Actions), has conducted a Telephone Interview with Applicant's Representative, and has reviewed an Appeal Brief filed by the Applicants. Significantly, in the course of examining the present application, the Examiner has conducted no less than 5 (**FIVE**) **substantive examinations** of the claims. Furthermore, at least four different Primary or Supervisory Examiners (N. E. Haely [*sic*?], Mr. Larry D. Donaghue, Mr. Bunjob Jaroenchonwanit, and Mr. F. Ryan Zeender) have examined the present application at one point or another.

In light of:

- (1) the prosecution history so far,

- (2) the fact that the Examiner has not deemed it necessary to perform a prior art search in examining the present application since the Third Office Action,
- (3) the extensive supervisory review performed by four different Primary or Supervisory Examiners, and
- (4) the fact that the Applicants have not amended the independent claims since the response to the Second Office Action

it is quite clear that there cannot possibly be any serious burden in examining all of the present claims in the same application. If such serious burden has ever existed, it would have been found and a restriction requirement would have been made long before the present Office Action.

Indeed, by issuing the first Restriction Requirement on September 22, 2004, Examiner Ramsey Refai already made the determination that examining the now restricted claims would **not** constitute a serious burden on the Examiner.

Additionally, in the present (i.e., Sixth) Office Action, each of the four Groups are classified in the same class, i.e., class 713. Therefore, any prior art search would be limited to a single class. Furthermore, Groups II and III are classified in the same subclass (i.e., subclass 310).

Furthermore, even if it is assumed for the sake of argument that the Office Action has managed to establish the *prima facie* showing of a serious burden as required by MPEP § 803 (which it has NOT), the mere fact that the Examiner issued five Office Actions on the merits (two of which were Final) and performed at least two separate prior art searches is sufficient evidence to rebut any *prima facie* showing of a serious burden.

For these reasons, the Applicant respectfully submits that there is no serious burden in examining all of the present claims in the same application. Thus, the Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

III. CONCLUSION

The Applicants believe that all issues raised in the Office Action have been addressed. Reconsideration of the Restriction Requirement and further examination on the merits are respectfully requested.

The Examiner is invited to telephone the undersigned at (408) 414-1080 ext. 229 to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this Response. The Commissioner is authorized to charge any fee that may be due and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
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